



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/752,330	12/29/2000	Ravindra R. Mantena	YOR920000552US1	8671

23405 7590 01/17/2006

HESLIN ROTHENBERG FARLEY & MESITI PC
5 COLUMBIA CIRCLE
ALBANY, NY 12203

EXAMINER

HAQ, NAEEM U

ART UNIT	PAPER NUMBER
----------	--------------

3625

DATE MAILED: 01/17/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/752,330

Applicant(s)

MANTENA ET AL.

Examiner

Naeem Haq

Art Unit

3625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 October 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-48 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-48 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 October 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

This action is in response to the Applicants' amendment filed on October 27, 2005. Claims 1-48 are pending and will be considered for examination.

Applicants' amendment to Figure 1 is sufficient to overcome the objection given in the previous Office Action. This objection to Figure 1 is withdrawn.

Final Rejection

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-48 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-45 of copending Application No. 09/751,078 (US 2002/0087477 A1).

Art Unit: 3625

This is a provisional obviousness-type double patenting rejection. Application 09/751,078 substantially claims the same invention. The difference between these two applications is found to be non-functional descriptive material. Such differences are merely subjective and will not distinguish the claimed invention in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994) also see MPEP 2106. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to request any information because such information does not functionally relate to the steps of the claimed method and because the subjective interpretation of information does not patentably distinguish the claimed invention.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-48 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 1, 13, 25, and 37 recite the limitation "preexisting entitlement". It is unclear to the Examiner what this limitation means. For examination purposes, the examiner will assume that this limitation means a contract.

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1-3, 9-11, 13-15, 21-23, 25-27, 33-35, 37-39, and 45-47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lidow (US 6,889,197 B2).

Referring to claims 1-3, 13-15, 25-27, and 37-39, Lidow teaches a method of providing an entitled price in an electronic transaction comprising: electronically sending by a requestor a request for information based on a preexisting entitlement (i.e. contract) from a public electronic environment (col. 7, lines 34-53; col. 23, line 64 – col. 24, line 7; col. 26, lines 62-67; Fig. 22); automatically routing the request to a private electronic environment (col. 9, lines 25-35; col. 25, lines 22-26; Figure 24, item “74”; col. 27, lines 20-42); obtaining an entitled price within the private electronic environment in real time while the requestor waits (col. 23, line 64 – col. 24, line 7; Figure 17, items “74” and “266”; Figure 24, item “74”; col. 27, lines 43-55); automatically returning the entitled price from the private electronic environment to the public electronic environment for providing to the requestor (col. 24, lines 19-39), wherein the public electronic environment comprises a front end application, private electronic environment comprises a back end Enterprise Resource Planning application, electronically sending comprises electronically sending by the requestor the request via the front end application, automatically routing the request to the ERP application, obtaining the entitled price from the ERP application while the requestor waits, returning the entitled price from the ERP application to the front end application for providing to the requestor

Art Unit: 3625

(col. 27, lines 20-67), wherein returning is accomplished at least in part by messaging middleware (col. 27, lines 56-67). Lidow does not teach that the information requested is an entitled price. However, the Examiner notes that this limitation is not functionally involved in the elements of the recited method. Therefore this limitation is deemed to be nonfunctional descriptive material. The steps of sending, routing, obtaining and returning would be performed the same regardless of what information the request contained. The difference between the content of the Applicant's information request and the prior art's demand is merely subjective. Thus this nonfunctional descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994) also see MPEP 2106. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to request any information in the invention of Lidow because such information does not functionally relate to the steps of the claimed method and because the subjective interpretation of information does not patentably distinguish the claimed invention.

Referring to claims 9-11, 21-23, 33-35, 45-47, Lidow teaches that the public electronic environment comprises a global computer network (col. 26, lines 62-67). Lidow does not expressly teach that the front end application comprises a browser. However, Lidow teaches that the supply chain server 74 provides a web page with HTML or Java data (col. 27, lines 8-13). Therefore it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to have the customer use a

Art Unit: 3625

browser in the invention of Lidow. One of ordinary skill in the art would have been motivated to do so in order to view the HTML and Java data in a graphically enhanced user interface.

Claims 4-8, 16-20, 28-32, and 40-44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lidow (US 6,889,197 B2) in view of Multiplatforms.

Referring to claim 4-8, 16-20, 28-32, and 40-44. Lidow discloses an invention according to claims 3, 15, 27, and 39 as indicated supra. Lidow does not expressly disclose a method wherein the messaging middleware comprises MQSERIES, MSMQ and the ESP application comprises BMN. However, Multiplatforms teach that enterprise software vendors have come to support multiple platforms (Multiplatforms: page 2). The examiner notes, the specific type of middleware being utilized by the instant invention does not act to distinguish the instant invention in terms of patentability. Numerous middleware applications and ESP configurations could have been implemented and successfully utilized. Therefore, at the time the invention was made, it would have been obvious to a person of ordinary skill in the art to have modified the invention of Lidow to have included various middleware applications and ESP configurations as discussed above because multiple platform support from ERP vendors and greater platform interoperability means that manufacturing manages can consider a wider range of applications (Multiplatforms: page 3).

Claims 12, 24, 36, and 48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lidow (US 6,889,197 B2) in view of Official Notice.

Art Unit: 3625

Lidow teaches or suggests all the limitations of claims 11, 23, 35, and 47 as noted above. Lidow does not teach encrypting and decrypting the communication between the various parties and systems. However, Official Notice is taken that it is old and well known in the art to encrypt and decrypt electronic messages. Therefore it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to incorporate encryption and decryption into the invention of Lidow. One of ordinary skill in the art would have been motivated to do so in order to secure the communication between the various parties and systems.

Response to Arguments

The following is in response to the arguments filed on October 27, 2005.

Applicants' arguments with respect to the Double Patenting rejection have been fully considered but they are not persuasive. The Applicants have argued that *In re Lowry* "...stands for the proposition that printed matter case law is inapplicable to computer-based inventions..." The Examiner respectfully disagrees with this interpretation of *In re Lowry*. The rejection by the Board was overturned not on the grounds that printed matter is inapplicable to computer-based inventions as alleged by the Applicants but because the Federal Circuit found that Lowry's data structure had a functional relationship to the structural elements of the claim. Specifically, the Federal Circuit stated, "...the claims require specific electronic structural elements which impart a physical organization on the information stored in memory" and "...Lowry's data structures impose a physical organization on the data." In the present case, the data in

Art Unit: 3625

the Applicants' claims from application 09/751,078 and the current application do not have any functional relationship to the structural elements of the claims because the steps and structure of the claims are not responsive to or dependent on the format or content of the information being sent or received. Thus, the data is deemed to be non-functional descriptive material, and the Examiner maintains the double patenting rejection.

Applicants' arguments with respect to the rejection of claims 1-48 under 35 U.S.C. 112, first paragraph, have been fully considered and are persuasive. The rejection of these claims under 35 U.S.C. 112, first paragraph has been withdrawn.

The Examiner notes that the Applicants did not respond to the Examiner's rejection of claims 1-48 under 35 U.S.C. 112, second paragraph. Therefore, this rejection is maintained.

Applicant's arguments with respect to the rejection of claims 1-3, 9-11, 13-15, 21-23, 25-27, 33-35, 37-39, and 45-47 under 35 U.S.C. 103 have been fully considered but they are not persuasive. As analyzed above, the limitation "entitled price" is deemed to be non-functional descriptive material because the steps and structure of the claims are not responsive to or dependent on the format or content of the information being sent or received. The Applicants have argued that the limitation "entitled price" cannot be ignored (page 14). The Examiner agrees and notes that this limitation was not ignored in the analysis. The claims have been considered as a whole, and as analyzed in the previous action, includes nonfunctional descriptive material. Nonfunctional descriptive material cannot render nonobvious an invention that would have otherwise been

Art Unit: 3625

obvious. *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983)

(when descriptive material is not functionally related to the substrates, the descriptive material will not distinguish the invention from the prior art in terms of patentability).

The Examiner notes that the Applicants did not respond to the Examiner's rejection of claims 12, 24, 36, and 48 under 35 U.S.C. 103(a) over Lidow in view of Official Notice. In order to adequately traverse a rejection based on common knowledge (i.e. Official Notice), an Applicant must specifically point out the supposed errors in the Examiner's action, which would include stating why the noticed fact is not considered to be common knowledge or well-known in the art. A general allegation that the claims define a patentable invention without any reference to the Examiner's assertion of Official Notice is inadequate. In the present case, the Applicants did not respond to the Examiner's rejection using Official Notice. Furthermore, the Applicants failed to argue why the noticed fact is not considered to be common knowledge or well-known in the art. Instead, the Applicants have provided a general allegation of patentability of claims 1, 13, 25, and 37. For this reason, Applicants' response is considered to be an inadequate traversal of the Official Notice used by the Examiner in the rejection of claims 12, 24, 36, and 48 under 35 U.S.C. §103.

Since the Applicants have failed to seasonably challenge the Examiner's Official Notice presented in the previous Office Actions, the Examiner now interprets all Official Notices as admitted prior art. *Applicant must seasonably challenge well known statements and statements based on personal knowledge when they are made. In re Selmi*, 156 F.2d 96, 70 USPQ 197 (CCPA 1946). *If Applicant does not seasonably*

Art Unit: 3625

traverse the well known statement during examination, then the object of the well known statement is taken to be admitted prior art. In re Chevenard, 139 F.2d71, 60 USPQ 239 (CCPA 1943). Also see MPEP 2144.03.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Naeem Haq whose telephone number is (571)-272-6758. The examiner can normally be reached on M-F 8:00am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wynn W. Coggins can be reached on (571)-272-7159. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.


Art Unit: 3625

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Naeem Haq, Patent Examiner
Art Unit 3625

January 10, 2006


J.C. Gasp
Primary Ex